

AMENDMENT

Serial No. 08/454,529
Atty. Docket No. GP004-16.DV4

Remarks

Claims 486-560 and 563-630 are presently pending in the subject application.

Reconsideration and allowance are respectfully requested in view of the above amendments and the following remarks.

Claims 561 and 562 have been canceled herein without prejudice. The subject matter of these claims has now been incorporated into amended claims 488 and 489.

Claims 486-491 and 603 have been amended herein in the manner indicated below and to make editorial changes. These claims and claim 604 have also been amended herein to change the target region in a location corresponding to bases 980-1060 of *E. coli* 16S rRNA, or the encoding DNA, to a target region in a location corresponding to bases 975-1060 of *E. coli* 16S rRNA or the encoding DNA. This amendment is supported in the specification at page 61, line 14 *et seq.*, and is consistent with presently pending claims 607 and 608, which depend from claim 603.

Rejection Under 35 U.S.C. § 102(e)

Claims 486-491, 509, 512, 513, 555-558, 561, 562, 603, 604, 609 and 610 stand rejected by the Examiner under 35 U.S.C. § 102 (e) as being anticipated by Stanbridge *et al.* (U.S. Patent No. 5,851,767). Applicants respectfully traverse this rejection for the reasons that follow.

Stanbridge is cited by the Examiner for disclosing probes that are capable of distinguishing mycoplasma organisms from *E. coli*. Specifically, Stanbridge is noted for disclosing probes located in the *Mycoplasma* 16S rRNA gene sequence at positions 1026-1041 and 1273-1288. Based on this disclosure, the Examiner contends that Stanbridge anticipates those claims covering a hybridization method for distinguishing target mycoplasma organisms (*e.g.*, *M. pneumoniae*) from *E. coli* at positions corresponding to bases 980-1060 and 1250-1290 of *E. coli* 16S rRNA or rDNA.

In an effort to advance prosecution of this application, Applicants have made several amendments to the claims herein. First, Applicants have amended claims 486 and 487 to indicate

AMENDMENT

Serial No. 08/454,529
Atty. Docket No. GP004-16.DV4

that if the one or more target species include at least one species of *Mycoplasma*, then the target region is in a location corresponding to bases 65-108, 190-230, 450-490, 820-860 or 1255-1290 of *E. coli* 16S rRNA or the encoding DNA. This amendment is supported in the specification at page 55, lines 11-17, and page 57, lines 28-32. Second, claims 490 and 491 have been amended to incorporate a limitation of claim 603, specifying that if the target region is in a location corresponding to bases 980-1060 of *E. coli* 16 S rRNA, or the encoding DNA, then the first genus is either *Campylobacter*, *Legionella* or *Mycobacterium*. Both of these amendments distinguish the presently claimed invention over Stanbridge, as the sequences appearing in column 2, lines 15-49, of Stanbridge are only disclosed to be useful for distinguishing mycoplasma organisms from *E. coli* or prokaryotic organisms from eukaryotic organisms. Similar amendments to claims 488 and 489 were deemed unnecessary in view of Stanbridge, who does not disclose probes for distinguishing between mycoplasma species, whereas claims 488 and 489 specify that the target and non-target groups must include species belonging to the same genus. Third, claims 486 and 487 have been further amended to indicate that if the target region is in a location corresponding to bases 1255-1290 of *E. coli* 16S rRNA, or the encoding DNA, then the target species is *Mycoplasma pneumoniae* and the at least one non-target species includes a mycoplasma species other than *Mycoplasma pneumoniae*. This amendment is supported in the specification at page 57, line 28 *et seq.*, and original claim 99, and distinguishes over Stanbridge who does not disclose probes for differentiating between mycoplasma species but rather targets mycoplasmas as a group. Claim 603 has been amended consistent with the amendments to claims 490 and 491.

For the reasons set forth above, Applicants submit that the claims are fully patentable in view of Stanbridge. Accordingly, withdrawal of the Examiner's anticipation rejection under 35 U.S.C. § 102(e) is hereby respectfully requested.

AMENDMENT

Serial No. 08/454,529
Atty. Docket No. GP004-16.DV4**Claim Objections**

Claims 492-508, 510, 511, 514-554, 559, 560, 563-602, 605-608 and 611-630 stand objected to by the Examiner as being dependent upon a rejected base claim. Because Applicants believe that the indicated claims should be allowable for the reasons set forth above, Applicants respectfully decline the Examiner's invitation to rewrite the objected to claims in independent form, including all of the limitations of the base claim and any intervening claims, at this time.

Applicants submit that the subject application is in condition for allowance and early notice to that effect is earnestly solicited.

Applicants note that the fee due for a three-month extension of time was previously charged in connection with their Amendment filed on June 9, 2004. Accordingly, no fee is believed due in connection with this Communication. If Applicants are mistaken, please charge any amount due to Deposit Account No. 07-0835 in the name of Gen-Probe Incorporated.

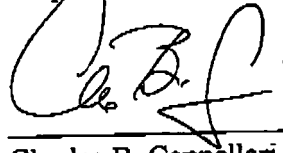
AMENDMENT

Serial No. 08/454,529
Atty. Docket No. GP004-16.DV4

Certificate of Transmission

I hereby certify that this correspondence (and any referred to as attached or enclosed) is being sent by facsimile to 703-872-9306 on the date indicated below to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Respectfully submitted,



By:

Charles B. Cappellari
Registration No. 40,937
Attorney for Applicants

Date: November 9, 2004

GEN-PROBE INCORPORATED
Patent Department
10210 Genetic Center Drive
San Diego, California 92121
PH: 858-410-8927
FAX: 858-410-8928